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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/579,733 12/28/95 NOBUTA

H 862.1351

005514 WM31/0405
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NEW YORK NY 10112

EXAMINER

WALLERSON, M

ART UNIT

PAPER NUMBER

2622

25

DATE MAILED:

04/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/579,733

Applicant(s)
Nobuta et al

Examiner
Mark Wallerson

Group Art Unit
2622



☒ Responsive to communication(s) filed on Mar 26, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 24, 26, 27, 29, and 57-61 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 24, 26, 27, 29, and 57-61 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on **3/26/2001**.
2. This application has been reconsidered. Claims 24, 26, 27, 29, and 57-61 are pending.

Continued Prosecution Application

3. The request filed on 3/26/2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 080/579,733 is acceptable and a CPA has been established. An action on the CPA follows.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no disclosure in the original specification that image processing which cannot be performed in the second copying mode is performed in the first copying mode as claimed in new claims 60 and 61.

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Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 60 and 61 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no disclosure in the original specification that image processing which cannot be performed in the second copying mode is performed in the first copying mode as claimed in new claims 60 and 61.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 24, 27, 57, 59, 60, and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Kita et. al. (hereinafter referred to as Kita) (U. S. 5,021,892).

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With respect to claims 24 and 27, Kita discloses an image processing device (1) comprising a scanner (60) for inputting an image signal (column 5, lines 16-47); a control unit (which reads on 50, 51, 52, 54, 56, and buses (DB, AB, and CB)) including a control circuit (50) for controlling the device (column 4, lines 46-54) and performing necessary image processing on the image signal input from the scanner to provide a first processed image signal (column 5, lines 33-37); a bidirectional interface (5) for transmitting the image signal input by the scanner (60) under control of the control unit (50) to an external computer (8) (column 5, lines 65-67), which performs necessary image processing on the transmitted image signal (column 3, lines 46-48) to provide a second processed image signal, and receiving the second processed image signal from the external computer (the data being sent from the computer to the printer would have to pass through interface (5)) (column 5, lines 65-68); an output circuit (66 and 67) for outputting the first and second signals to a printer (3), wherein the device has a plurality of modes (column 6, line 50 to column 7, line 25) including a first copying mode (which reads on Image Input Function) in which the image signal inputted from the scanner is outputted to the printer using the external computer (8) (column 5, lines 65-68 and column 6, line 65 to column 7, line 7), and a second copying mode (which reads on Copy Function) in which the image signal inputted from the scanner is outputted to the printer without using the external computer (column 6, lines 50-55), the image signal from the scanner being transmitted in order of control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)), bidirectional interface (5), the external computer (8), the bidirectional interface (5), the control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)), and

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the output unit (66 and 67) in the first copying mode (column 5, lines 63-68) based on the second processed signal (which reads on the signal from the computer), and the image signal from said scanner (60) being transmitted in order of the control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)) and the output circuit (66 and 67) in the second mode (column 6, lines 51-55) so as to perform copying based on the first processed image signal (which reads on the image signal from the scanner).

With respect to claim 57, Kita discloses that the output means (3) includes a bidirectional interface (66).

With respect to claim 59, Kita discloses a density adjusting feature (figure 2, part 25).

With regard to claims 60 and 61, Kita discloses that image processing which cannot be performed in the second copying mode is performed in the first copying mode (which reads on if the computer is in an OFF-LINE status, image data from the scanner is output to the printer) (column 6, lines 47-55).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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10. Claims 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Kochis et. al. (hereinafter referred to as Kochis) (U. S. 5,218,458).

With respect to claims 26 and 29, Kita differs from claims 26 and 29 in that he does not clearly disclose that the computer has a modem capable of receiving and processing image data from the interface, and transmitting the data to a public telephone line. Kochis discloses a system that transmits a data file between two computer systems via a telephone line (110, figure 1), utilizing PC fax cards (which reads on a modem) (column 2, lines 53-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita wherein the computer would have a modem capable of receiving and processing image data from the interface, and transmitting the data to a public telephone line. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita by the teaching of Kochis in order to be able to transfer files between computer systems as taught by Kochis in column 1, lines 6-7.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Kenmochi et. al. (hereinafter referred to as Kenmochi) (U. S. 5,900,947).

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With respect to claim 58, Kita differs from claim 58 in that he does not clearly disclose that the scanner generates a color image signal. Kenmochi discloses a communications apparatus wherein a color reading unit may be utilized (column 11, lines 63-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita wherein the scanner would generate a color image signal. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita by the teaching of Kenmochi in order to output color data to the personal computer as disclosed by Kenmochi in column 12, lines 1-3.

Response to Arguments

13. Applicant's arguments filed 3/26/2001 have been fully considered but they are not persuasive.

Applicant submits that Kita does not perform a printing operation without requiring a user to operate the external device or personal computer. The Examiner again respectfully disagrees. Kita **clearly** discloses that the image processing device (1) may be operated in an OFF-LINE control manner, **independent of the personal computer** to perform a copying function - the image scanner supplying image signals to the printer (column 6, lines 47-55). This shows that the image input and image print functions are controlled by the device (1).

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Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

(703) 305-9731 (for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.
Sixth Floor (Receptionist)


MARK WALLERSON
PATENT EXAMINER

MARK WALLERSON